

**REMARKS**

Claims 89 and 130-177 are pending in this application. Claims 89, 130-131, 142 and 152 have been amended. Claims 178-187 are new.

Claims 89 and 130 have been amended to recite “hydroxyl, amino, alkylamino, arylamino, alkoxy, aryloxy, nitro, cyano, sulfonic acid, sulfate, phosphonic acid, phosphate, or phosphonate.” Support for this amendment is found in the specification at page 52, lines 21-28.

Claims 130, 131 and 142 have been amended to correct typographical errors.

Claim 152 has been amended to delete the term “substantially pure.” This claim now recites “85% by weight of the  $\beta$ -D isomer.” Support for this recitation is found in the specification at page 53, lines 26-30.

New claims 178-181, which recite subgenres of the compounds of claim 89, are supported, for example, by the embodiments found on page 44 of the specification.

New claims 182-183 recite methods of treatment in combination with a second anti-hepatitis C virus agent. Support for these claims is found, for example, in original claims 113-114 and in the specification at pages 18-20.

New claims 184-186 recite dosage units. Support for these claims is found, for example, in original claims 127-129.

New claim 187 recites a method of treatment wherein the host is a human. Support for this claim is found, for example, in the specification at page 20, lines 22-26.

No new matter is added by these amendments. Claims 89 and 130-177 stand rejected. Applicants respectfully request reconsideration of the pending rejections based on the amendments and the following comments. Applicants reserve the right to pursue unclaimed subject matter in subsequent divisional or continuation applications.

**I. Obviousness-Type Double Patenting Rejections**

**A. U.S. Patent No. 7,163,929.**

Claims 89 and 130-177 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 7,163,929 (“the ‘929 patent”). The claims of the ‘929 patent recite, *inter alia*, methods of

treating a flavivirus or pestivirus infection by administering compounds of a genus of pyrrolopyrimidine nucleosides.

An obviousness-type double patenting rejection is appropriate only when the claims at issue are not “patentably distinct” from the claims of a commonly owned earlier patent. *See Eli Lilly & Co. v. Barr Laboratories, Inc.*, 251 F.3d 955, 967 (Fed. Cir. 2001). A claim is not patentably distinct from an earlier patent claim if the later claim is “obvious over, or anticipated by, the earlier claim.” *Id.* at 968. Applicants request withdrawal of the double patenting rejection because the instant claims are not obvious over or anticipated by the claims of the ‘929 patent.

The instant claims recite methods of treating a Hepatitis C virus infection. Claims 1-31 of the ‘929 patent disclose methods of treating flavivirus or pestivirus infections, not Hepatitis C virus infections. Hepatitis C virus is not a flavivirus or pestivirus. Therefore, the instant claims are patentably distinct from the claims of the ‘929 patent, and the double patenting rejection of the instant claims should be withdrawn.

**B. U.S. Patent Application No. 11/005,472.**

The Examiner has provisionally rejected claims 89 and 130-177 on the ground of obviousness-type double patenting as allegedly being unpatentable over claims 2-17 and 19-75 of U.S. Patent Application No. 11/005,472. Applicants request deferral of this issue until an indication of allowable subject matter in each application.

**II. Claims Rejections under 35 U.S.C. § 112, Second Paragraph**

Claims 89 and 130-177 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite.

First, the Examiner alleges that claim 89 is indefinite for use of the term “substituted” without “clearly indicating the moieties which are intended to be substituted....” (Office Action, page 5). Specifically, the Examiner objects to the use of the term “substituted” with respect to optional substitution of the phenyl group in the definition of R<sup>1</sup> and R<sup>2</sup>. Solely to promote prosecution and without prejudice, claims 89 and 130 have been amended to list the optional phenyl substituents of R<sup>1</sup> and R<sup>2</sup>, as defined in the specification at page 52, lines 21-28.

Second, the Examiner alleges that the term “substantially pure” in claim 152 is indefinite. (Office Action, page 5). Solely to promote prosecution and without prejudice,

claim 152 has been amended to delete the term "substantially pure." The claims now recites "85% by weight of the  $\beta$ -D isomer."

For at least these reasons, Applicants respectfully request that the rejection of the instant claims under 35 U.S.C. § 112, second paragraph be withdrawn.

**CONCLUSION**

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

If the Examiner believes it would be useful to advance prosecution, the Examiner is invited to telephone the undersigned at (858) 314-1200.

Respectfully submitted,



Date: June 29, 2007

Dale Rieger

Reg. No. 43,045

**JONES DAY**  
222 East 41st Street  
New York, New York 10017  
(858) 314-1200